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REQUEST TO WITHDRAWAL FINALITY
EXPEDITED PROCEDURE
GROUP 1725
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q90171

Ian Anthony JONES, et al.

Appln. No.: 10/666,264

Group Art Unit: 1725

Confirmation No.: 7763

Examiner: Maria Alexandra Elve

Filed: September 19, 2003

For: WELDING METHOD

REQUEST TO WITHDRAW FINALITY

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant submits that the final Office Action dated September 12, 2007, improperly has been made final because it was not necessitated by Applicants' Amendment, and thus respectfully solicits withdrawal of the finality of the Office Action.

As background, in the non-final Office Action mailed on March 22, 2007, Claims 31-33, which ultimately depended from independent Claim 1, were not rejected based on prior art, and were rejected only under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement and for the presence in the claims of allegedly new matter. In reliance upon the position set forth in the Office Action, Applicants amended independent Claim 1 to incorporate the subject matter of Claims 31-33, removing the allegedly new matter in the process. Nevertheless, the Examiner repeated her previous rejections, citing additional art (the "Kaida" reference) to reject the subject matter that was previously present in Claim 31, but which was incorporated into independent Claim 1 in Applicants' Amendment.

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Applicants respectfully submit the rejection was improperly made final because it was not necessitated by Applicants' Amendment. MPEP § 706.03(o) clearly states that any new matter added to a claim "must be considered as part of the claimed subject matter and cannot be ignored." Accordingly, the Examiner was under an obligation to search the prior art for the subject matter of Claims 31-33 before issuing the previous Office Action. Because the Examiner did not present any prior art rejecting those claims, Applicants properly believed that amending the claims to incorporate Claims 31-33 into independent Claim 1 would overcome the cited prior art. Instead, the Examiner cited additional prior art which newly addressed subject matter that was not newly added by Applicants' Amendment.

Therefore, in view of the above, Applicants respectfully submit that the Office Action dated September 12, 2007, was improperly made final in view of the new grounds for rejection, which were not necessitated by amendments made by Applicants.

For the reasons discussed above, Applicants request that the finality of the Office Action be withdrawn and a new Non-Final Office Action be issued with a new time period for reply.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: October 11, 2007

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